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16/17 Pw

PATENT  
Customer No. 22,852  
Attorney Docket No. 5725.0895-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Continuation Application of: )  
)  
Mohamed KANJI et al. ) Group Art Unit: 1617  
)  
Application No.: 10/699,780 ) Examiner: S. Wang  
)  
Continuation Filed: November 4, 2003 )  
)  
For: METHODS OF DISPENSING AT )  
LEAST ONE COLORING AGENT )  
USING AT LEAST ONE )  
HETEROPOLYMER )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**NOTIFICATION OF PENDING LITIGATION**

Pursuant to MPEP § 2001.06(c), Applicants bring to the attention of the Examiner the existence of a pending litigation. Although Applicants do not consider the information material to patentability of the claimed invention, in an overabundance of caution, Applicants inform the Examiner that L'Oreal's U.S. Patent No. 6,716,420 B2, which is commonly assigned to the owner of the present application and claims related subject matter, is the subject of a patent infringement action filed by L'Oreal S.A. and L'Oreal USA, Inc. against Estee Lauder Companies, Inc., Estee Lauder, Inc., and Origins Natural Resources, Inc. in the United States District Court for the District of New Jersey. L'Oreal S.A. v. Estee Lauder Companies, Inc., Civ. No. 04-1660 (HAA) (D.N.J.

filed Apr. 7, 2004). A copy of the complaint and answer filed in this litigation are attached for the Examiner's consideration.

Please grant any extensions of time required to enter this communication and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: July 23, 2004

*Elin C. DeCarlo,*  
By: Reg. No. 51,688 *for*  
Lori-Ann Johnson  
Reg. No. 34,498



Kevin J. McKenna (KM 7530)  
Mara E. Zazzali (MZ 5293)  
Gibbons, Del Deo, Dolan,  
Griffinger & Vecchione  
A Professional Corporation  
One Riverfront Plaza  
Newark, NJ 07102-5496  
(973) 596-4500

*Attorneys for Plaintiffs*

4-7-04

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF NEW JERSEY

L'ORÉAL S.A. and  
L'ORÉAL USA, INC.,

Plaintiffs,

v.

ESTEE LAUDER COMPANIES, INC.,  
ESTEE LAUDER, INC., and  
ORIGINS NATURAL RESOURCES, INC.,

Defendants.

Civil Action No.:

**JURY TRIAL  
DEMANDED**

04-1660  
(HAA)

**COMPLAINT FOR PATENT INFRINGEMENT**

L'Oréal S.A. and L'Oréal USA, Inc. (collectively "Plaintiffs"), for their Complaint against Estee Lauder Companies, Inc., Estee Lauder, Inc., and Origins Natural Resources, Inc. (collectively "Defendants"), allege as follows:

**NATURE OF THE ACTION**

1. This is a civil action for patent infringement of Plaintiffs' United States Patent No. 6,716,420 B2 ("the '420 patent") directed to methods for making and using mascaras.

## THE PARTIES

2. Plaintiff L'Oréal S.A. is a corporation duly organized under the laws of France, with its principal place of business at 14, rue Royale, 75008 Paris, France.

3. Plaintiff L'Oréal USA, Inc. is a corporation duly organized under the laws of Delaware, having its corporate offices at 575 Fifth Avenue, New York, New York 10017 and having offices in Ridgewood and North Brunswick, New Jersey. L'Oréal USA is a wholly-owned subsidiary of L'Oréal S.A. and has wholly owned subsidiaries with manufacturing, research and development, and distribution facilities located in Clark, Franklin, Linden, Piscataway, Cranbury, Dayton, and North Brunswick, New Jersey.

4. Plaintiffs are engaged in the business of researching, developing, manufacturing, and selling cosmetic products, including mascaras, in New Jersey and elsewhere throughout the United States.

5. Upon information and belief, Defendant Estee Lauder Companies, Inc. is a Delaware corporation having its corporate offices and principal place of business at 767 5th Avenue, Suite 4200, New York, New York 10153.

6. Upon information and belief, Defendant Estee Lauder, Inc. is a Delaware corporation having its corporate offices and principal place of business at 767 5th Avenue, Suite 4200, New York, New York 10153. Upon information and belief, Estee Lauder, Inc. is a subsidiary of Estee Lauder Companies, Inc.

7. Upon information and belief, Defendant Origins Natural Resources, Inc. is a Delaware corporation having its corporate offices and principal place of business at 767 5th Avenue, Suite 4200, New York, New York 10153. Upon information and belief, Origins Natural Resources, Inc. is a subsidiary of Estee Lauder, Inc.

8. Upon information and belief, Defendants are engaged in the business of selling cosmetic products, including infringing mascaras, in New Jersey and elsewhere throughout the United States.

### **JURISDICTION AND VENUE**

9. This civil action for patent infringement arises under the Patent Laws of the United States, Title 35, United States Code.

10. This Court has subject matter jurisdiction over this case pursuant to 28 U.S.C. §§ 1331 and 1338(a).

11. Upon information and belief, Defendants purposefully have conducted and continue to conduct business in this judicial district, have caused injury to Plaintiffs in this judicial district, and have committed and/or caused acts of infringement of the '420 patent in this judicial district.

12. This Court has personal jurisdiction over Defendants.

13. Venue is proper in this judicial district under 28 U.S.C. §§ 1391 and 1400(b).

### **FIRST COUNT FOR PATENT INFRINGEMENT**

14. On April 6, 2004, the '420 patent, entitled "Methods of Use and of Making a Mascara Comprising at Least One Coloring Agent and at Least One Heteropolymer," was duly and legally issued to L'Oréal S.A. by the United States Patent and Trademark Office ("PTO"). A true and correct copy of the '420 patent is attached as Exhibit A.

15. Mohamed G. Kanji is the sole inventor of the claims of the '420 patent. In an Office Action dated August 11, 2003, issued during prosecution of the '420 patent, the PTO correctly deleted Sue Feng as a named inventor of the '420 patent. The PTO, however, erroneously failed to print that correction on the face of the '420 patent and incorrectly recited Sue Feng as a co-inventor.

16. Since the issuance of the '420 patent, L'Oréal S.A. has been and still is the owner of the '420 patent. L'Oréal USA is the exclusive licensee under the '420 patent.

17. The '420 patent discloses and claims methods of making and using certain mascara compositions that contain various ingredients.

18. Upon information and belief, subsequent to the issuance of the '420 patent, Defendants have made, used, offered to sell, sold, and/or imported mascara products in the United States, including mascaras marketed under the trade names "Pure Drama MagnaScopic Maximum Volume Mascara" and "Full Story Lush-lash Mascara" (collectively "the Accused Products").

19. Upon information and belief, the labeling of the Accused Products indicates that the products contain each of the ingredients specified by the claims of the '420 patent. True and correct copies of the ingredient labeling of representative samples of the Accused Products are attached as Exhibits B and C.

20. Upon information and belief, Defendants have been and still are directly infringing at least one claim of the '420 patent under 35 U.S.C. § 271(a) and/or 35 U.S.C. § 271(g) by making the Accused Products in the United States and/or importing those products into the United States in violation of Plaintiffs' patent rights and will continue to do so unless enjoined by this Court.

#### **SECOND COUNT FOR PATENT INFRINGEMENT**

21. Plaintiffs incorporate by reference paragraphs 1-20 of this Complaint as if fully set forth herein.

22. Upon information and belief, consumers and others who purchase the Accused Products use them in a manner that directly infringes at least one claim of the '420 patent.

23. Upon information and belief, Defendants know or should know that their steps in actively advertising, marketing, packaging, offering for sale, selling, and/or distributing the

Accused Products cause, urge, encourage, and/or aid consumers and others to directly infringe at least one claim of the '420 patent. Defendants therefore have been and still are actively inducing infringement of the '420 patent under 35 U.S.C. § 271(b) and will continue to do so unless enjoined by this Court.

24. Upon information and belief, Defendants have been and still are offering for sale and selling within the United States, and/or importing into the United States, the Accused Products, which constitute a material for use in practicing the process of at least one claim of the '420 patent. The Accused Products further constitute a material part of the invention of the '420 patent and are not staple articles or commodities of commerce suitable for substantial noninfringing use. Upon information and belief, Defendants know that the Accused Products were especially made or especially adapted for use in an infringement of the '420 patent. Defendants therefore have been and still are contributorily infringing the '420 patent under 35 U.S.C. § 271(c) and will continue to do so unless enjoined by this Court.

#### **DAMAGES AND OTHER HARM SUFFERED BY PLAINTIFFS**

25. Plaintiffs have been damaged in an amount not yet determined as a consequence of the infringing activities complained of herein and will continue to be damaged until this Court permanently enjoins Defendants from further infringement of the '420 patent.

26. Plaintiffs have been irreparably harmed as a consequence of the infringing activities complained of herein and will continue to be irreparably harmed until this Court permanently enjoins Defendants from further infringement of the '420 patent.

#### **PRAYER FOR RELIEF**

WHEREFORE, Plaintiffs respectfully request that this Court enter a judgment:

- (1) finding Defendants liable to Plaintiffs for infringement of the '420 patent;



(2) permanently enjoining Defendants, their officers, agents, servants, employees, and attorneys, and those other persons or entities in active concert or participation with them, from infringing any claim of the '420 patent under 35 U.S.C. § 271(a) and/or 35 U.S.C. § 271(g);

(3) permanently enjoining Defendants, their officers, agents, servants, employees, and attorneys, and those other persons or entities in active concert or participation with them, from actively inducing infringement of any claim of the '420 patent under 35 U.S.C. § 271(b);

(4) permanently enjoining Defendants, their officers, agents, servants, employees, and attorneys, and those other persons or entities in active concert or participation with them, from contributing to infringement of any claim of the '420 patent under 35 U.S.C. § 271(c);

(5) correcting the recitation of inventorship of the '420 patent pursuant to 35 U.S.C. § 256 to name Mohamed G. Kanji as the sole inventor;

(6) awarding Plaintiffs damages adequate to compensate them for Defendants' infringement of the '420 patent, together with prejudgment interest thereon; and

(7) awarding Plaintiffs their reasonable attorney fees pursuant to 35 U.S.C. § 285, costs of suit, and such further and additional relief as this Court deems just and proper.

**JURY DEMAND**

Plaintiffs demand a jury trial on all issues triable to a jury in this matter.

Dated: Newark, New Jersey  
April 7, 2004



Kevin J. McKenna (KM 7530)  
Mara E. Zazzali (MZ 5293)  
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1300 I Street, N.W., Suite 700  
Washington, DC 20005-3315  
(202) 408-4000

**Complaints and Other Initiating Documents**

2:04-cv-01660-HAA-GDH L'OREAL S.A. et al v. ESTEE LAUDER COMPANIES, INC. et al

**U.S. District Court**

**District of New Jersey [LIVE]**

**Notice of Electronic Filing**

The following transaction was received from KEVIN J. MCKENNA entered on 4/13/2004 at 10:43 AM EDT and filed on 4/7/2004

**Case Name:** L'OREAL S.A. et al v. ESTEE LAUDER COMPANIES, INC. et al

**Case Number:** 2:04-cv-1660

**Filer:** L'OREAL USA, INC.  
L'OREAL S.A.

**Document Number:** 1

**Docket Text:**

COMPLAINT against ESTEE LAUDER COMPANIES, INC., ESTEE LAUDER, INC., ORGINS NATURAL RESOURCES, INC. ( Filing fee \$ 150 receipt number 322571.) JURY DEMAND, filed by L'OREAL S.A., L'OREAL USA, INC..(dr,)

The following document(s) are associated with this transaction:

**Document description:**Main Document

**Original filename:**n/a

**Electronic document Stamp:**

[STAMP dcecfStamp\_ID=1046708974 [Date=4/13/2004] [FileNumber=136477-0]  
[2a1362f610f98f8ee03a10df299ce7103ed46d5617a70050ac8e84c8207b567a8758  
b3ddf5f508b996d95bf0d0caca7667b7cacf50762002bb674a955a1b7704]]

**2:04-cv-1660 Notice will be electronically mailed to:**

KEVIN J. MCKENNA kmckenna@gibbonslaw.com,

**2:04-cv-1660 Notice will not be electronically mailed to:**

**Service of Process:**

2:04-cv-01660-HAA-GDH L'OREAL S.A. et al v. ESTEE LAUDER COMPANIES, INC. et al

**U.S. District Court**

**District of New Jersey [LIVE]**

**Notice of Electronic Filing**

The following transaction was received from dr, entered on 4/13/2004 at 10:45 AM EDT and filed on 4/13/2004

**Case Name:** L'OREAL S.A. et al v. ESTEE LAUDER COMPANIES, INC. et al

**Case Number:** 2:04-cv-1660

**Filer:**

**Document Number:**

**Docket Text:**

Summons Issued as to ESTEE LAUDER COMPANIES, INC., ESTEE LAUDER, INC., ORGINS NATURAL RESOURCES, INC..Days Due - 20. Mailed to COunsel (dr, )

The following document(s) are associated with this transaction:

**2:04-cv-1660 Notice will be electronically mailed to:**

KEVIN J. MCKENNA kmckenna@gibbonslaw.com,

**2:04-cv-1660 Notice will not be electronically mailed to:**



ESTÉE LAUDER

MagnaScopic

Maximum Volume

Mascara

Mascara

volume intense

NET WT.  
3 OZ./9ml e

INGREDIENTS: WATER (AQUA PURIFICATA) PURIFIED • ISODODECANE • ETHYLENEDIAMINE/STEARYL DIMER TALLATE COPOLYMER • CYCLOMETHICONE • KADLIN • STEARIC ACID • STEARAMIDE MEA-  
STEARATE • AMMONIUM SHELLACATE • POLYSORBATE 20 • SILICA • SORBITAN TRISTEARATE • GLYCERYL STEARATE • PEG-100 STEARATE • MAGNESIUM ALUMINUM SILICATE • HYDROXYETHYLCELLULOSE •  
PVP • TOCOPHERYL ACETATE • ACACIA SENEGAL GUM • PTFE • COFFEA ARABICA (COFFEE) SEED EXTRACT • PANOTHENIC ACID POLYPEPTIDE • HYDROLYZED JOJOBA PROTEIN • SILK AMINO ACIDS •  
AMINOMETHYL PROPANEDIOL • PROPYLENE GLYCOL • TETRADECYL PENTABUTYRITOL • HYDROXYETHYLACRYLATE • ISOPROPYL ALCOHOL • DISODIUM EDTA • CHLORPHENESIN • SORBIC ACID • PHENOXYE-  
THANOL • METHYL PARABEN • BUTYL PARABEN • ETHYL PARABEN • PROPYL PARABEN • ISOBUTYL PARABEN • (+/-) (MAY CONTAIN) MICA • TITANIUM DIOXIDE (CI 77891) • IRON OXIDES (CI 77491, CI 77492,  
CI 77499) • BRONZE POWDER (CI 77400) • BLUE 1 (CI 42090) • ALUMINUM POWDER (CI 77000) • YELLOW 5 (CI 19140) • FERRIC FERROCYNANIDE (CI 77510) • YELLOW 5 LAKE (CI 19140) • ULTRAMARINES  
(CI 77007) • CARMINA (CI 75470) • CHROMIUM HYDROXIDE GREEN (CI 77289) • CHROMIUM OXIDE GREENS (CI 77288) • BISMUTH OXYCHLORIDE (CI 77163) • BLUE 1 LAKE (CI 42090) <LN23554>

# ORIGINS

**Full Story™**

Lush-lash mascara/Mascara épaississant

.27 fl. oz./oz.liq./8 ml 

**Ingredients:** aqueous (water, aqua purificata, purified) infusions; rosa damascena (rose), anthemis nobilis (chamomile) • isododecane • ethylenediamine/stearyl dimer talate copolymer • kaolin • ammonium stearate • stearamide mea-stearate • polysorbate 20 • polyurethane-1 • silica • sorbitan tristearate • pvp • panthenol • tocopheryl acetate • glycerin • tocopherol • butylene glycol • diglycol/chdm/isophthalates/sip copolymer • stearic acid • acacia senegal gum • magnesium aluminum silicate • hydroxyethylcellulose • glyceryl stearate • peg-100 stearate • tetradibutyl pentaerithrityl hydroxyhydrocinnamate • citric acid • disodium edta • benzyl alcohol • potassium sorbate • sorbic acid • chlorphenesin • phenoxyethanol • methylparaben • ethylparaben • propylparaben • isobutylparaben • [+/- (may contain) mica • titanium dioxide (ci 77891) • iron oxides (ci 77491, ci 77492, ci 77499) • ferric ferrocyanide (ci 77510) • ultramarines (ci 77007) • blue 1 lake (ci 42090) • bismuth oxychloride (ci 77163) • chromium hydroxide green (ci 77289) • chromium oxide greens (ci 77288) • yellow 5 lake (ci 19140)] <ln23617>

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# CIVIL COVER SHEET

The JS-44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

## I (a) PLAINTIFFS

L'Oréal S.A. and L'Oréal USA, Inc.

(b) COUNTY OF RESIDENT OF FIRST LISTED PLAINTIFF  
(EXCEPT IN U.S. PLAINTIFF CASES)

Paris, France

(c) ATTORNEYS (FIRM NAME, ADDRESS, AND TELEPHONE NUMBER)

Enter Attorney Name  
Gibbons, DelDeo, Dolan, Griffinger & Vecchione, P.C.  
One Riverfront Plaza  
Newark, New Jersey 07102  
(973) 596-4500

## DEFENDANTS

Estee Lauder Companies, Inc., Estee Lauder, Inc. and  
Origins Natural Resources, Inc.

COUNTY OF RESIDENCE OF FIRST LISTED DEFENDANT  
(IN U.S. PLAINTIFF CASES ONLY)

New York, New York

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE TRACT OF LAND INVOLVED

ATTORNEYS (IF KNOWN)

Enter Attorney Name

47-04

## II. BASIS OF JURISDICTION

(PLACE AN x IN ONE BOX ONLY)

- ☐ 1 U.S. Government Plaintiff ☒ 3 Federal Question (U.S. Government Not a Party)
- ☐ 2 U.S. Government Defendant ☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

## III. CITIZENSHIP OF PRINCIPAL PARTIES

(For Diversity Cases Only)

(PLACE AN x IN ONE BOX FOR PLAINTIFF AND ONE BOX FOR DEFENDANT)

- |   |   |  |   |
|---|---|--|---|
| Citizen of This State                   | PTF <input type="checkbox"/> 1 DEF <input type="checkbox"/> 1 | Incorporated or Principal Place of Business in This State    | PTF <input type="checkbox"/> 4 DEF <input type="checkbox"/> 4 |
| Citizen of Another State                | <input type="checkbox"/> 2 <input type="checkbox"/> 2         | Incorporated or Principal Place of Business in Another State | <input type="checkbox"/> 5 <input type="checkbox"/> 5         |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 <input type="checkbox"/> 3         | Foreign Nation   | <input type="checkbox"/> 6 <input type="checkbox"/> 6         |

## IV. ORIGIN

(PLACE AN x IN ONE BOX ONLY)

- ☒ 1 Original Proceeding ☐ 2 Removed from State Court ☐ 3 Remanded from Appellate Court ☐ 4 Reinstated or Reopened
- Transferred from ☐ 5 Another district (specify) ☐ 6 Multidistrict Litigation ☐ 7 Judge from Magistrate Judgment

## V. NATURE OF SUIT (PLACE AN x IN ONE BOX ONLY)

| CONTRACT  | TORTS  | FORFEITURE/PENALTY   | BANKRUPTCY   | OTHER STATUTES   |
|---|--|--|--|--|
| <input type="checkbox"/> 110 Insurance  | <input type="checkbox"/> 310 Airplane                          | <input type="checkbox"/> 610 Agriculture                                 | <input type="checkbox"/> 422 Appeal                              | <input type="checkbox"/> 400 State Reapportionment                                     |
| <input type="checkbox"/> 120 Marine   | <input type="checkbox"/> 315 Airplane Product                  | <input type="checkbox"/> 620 Other Food & Drug                           | <input type="checkbox"/> 423 28 USC 158                          | <input type="checkbox"/> 410 Antitrust   |
| <input type="checkbox"/> 130 Miller Act   | <input type="checkbox"/> 320 Liability Assault & Libel Slander | <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 | <input type="checkbox"/> 423 Withdrawal 28 USC 157               | <input type="checkbox"/> 430 Banks and Banking   |
| <input type="checkbox"/> 140 Negotiable Instrument                                | <input type="checkbox"/> 330 Federal Employers' Liability      | <input type="checkbox"/> 630 Liquor Laws                                 | <input type="checkbox"/> 820 Copyrights                          | <input type="checkbox"/> 450 Commercial/ICC Rates/etc.                                 |
| <input type="checkbox"/> 150 Recovery of Overpayment and enforcement of Judgment  | <input type="checkbox"/> 340 Marine                            | <input type="checkbox"/> 640 RR & Truck                                  | <input type="checkbox"/> 830 Patent                              | <input type="checkbox"/> 460 Deportation   |
| <input type="checkbox"/> 151 Medicare Act   | <input type="checkbox"/> 345 Marine Product Liability          | <input type="checkbox"/> 650 Airline Regs                                | <input type="checkbox"/> 840 Trademark                           | <input type="checkbox"/> 470 Racketeer Influenced                                      |
| <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) | <input type="checkbox"/> 350 Motor Vehicle                     | <input type="checkbox"/> 660 Occupational Safety/Health                  | <input type="checkbox"/> 861 MIA (1395(f))                       | <input type="checkbox"/> 810 Selective Service   |
| <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits        | <input type="checkbox"/> 355 Motor Vehicle Product Liability   | <input type="checkbox"/> 690 Other                                       | <input type="checkbox"/> 862 Black Lung (923)                    | <input type="checkbox"/> 850 Securities/Commodities/Exchange                           |
| <input type="checkbox"/> 160 Stockholder's Suits                                  | <input type="checkbox"/> 360 Other Personal Injury             | <input type="checkbox"/> 710 Fair Labor Standards Act                    | <input type="checkbox"/> 863 DIWC/DIWW (405(g))                  | <input type="checkbox"/> 875 Customer Challenge 12 USC 3410                            |
| <input type="checkbox"/> 190 Other Contract                                       | <input type="checkbox"/> 370 Other Fraud                       | <input type="checkbox"/> 720 Labor/Mgmt. Relations                       | <input type="checkbox"/> 864 SSID Title (XVI)                    | <input type="checkbox"/> 891 Agricultural Acts   |
| <input type="checkbox"/> 195 Contract Product Liability                           | <input type="checkbox"/> 380 Other Personal Property Damage    | <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act      | <input type="checkbox"/> 865 RSI (405(g))                        | <input type="checkbox"/> 892 Economic Stabilization Act                                |
|   | <input type="checkbox"/> 385 Product Liability                 | <input type="checkbox"/> 740 Railway Labor Act                           | <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) | <input type="checkbox"/> 893 Environmental Matters                                     |
|   | <input type="checkbox"/> 390 Truth in Lending                  | <input type="checkbox"/> 790 Other Labor Litigation                      | <input type="checkbox"/> 871 IRS-Third Party 26 USC 7609         | <input type="checkbox"/> 894 Energy Allocation Act                                     |
|   | <input type="checkbox"/> 395 Other Personal Injury             | <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act                |  | <input type="checkbox"/> 895 Freedom of Information Act                                |
|   | <input type="checkbox"/> 400 Other Civil Rights                |  |  | <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice |
|   | <input type="checkbox"/> 441 Voting                            |  |  | <input type="checkbox"/> 950 Constitutionality of State Statutes                       |
|   | <input type="checkbox"/> 442 Employment                        |  |  | <input type="checkbox"/> 890 Other Statutory Actions                                   |
|   | <input type="checkbox"/> 443 Housing/Accommodations            |  |  |  |
|   | <input type="checkbox"/> 444 Welfare                           |  |  |  |
|   | <input type="checkbox"/> 440 Other Civil Rights                |  |  |  |
|   | <input type="checkbox"/> 441 Voting                            |  |  |  |
|   | <input type="checkbox"/> 442 Employment                        |  |  |  |
|   | <input type="checkbox"/> 443 Housing/Accommodations            |  |  |  |
|   | <input type="checkbox"/> 444 Welfare                           |  |  |  |
|   | <input type="checkbox"/> 440 Other Civil Rights                |  |  |  |

## VI. CAUSE OF ACTION

(CITE THE U.S. CIVIL STATUTE UNDER WHICH YOU ARE FILING AND WRITE A BRIEF STATEMENT OF CAUSE)

DO NOT CITE JURISDICTIONAL STATUTES UNLESS DIVERSITY

## VII. REQUESTED IN COMPLAINT:

CHECK IF THIS IS A  
☐ UNDER F.R.C.P. 23

CLASS ACTION

DEMAND \$

Check YES only if demanded in complaint:

JURY DEMAND: ☒ YES ☐ NO

## VIII. RELATED CASE(S) IF ANY

(See instructions)

JUDGE

DOCKET NUMBER

DATE

SIGNATURE OF ATTORNEY OF RECORD

July 7, 2004

For Office Use Only

RECEIPT #

AMOUNT

APPLYING IFP

JUDGE

MAG. JUDGE

# INSTRUCTIONS FOR ATTORNEYS COMPLETING CIVIL COVER SHEET FORM JS-44

## Authority for Civil Cover Sheet

The JS-44 cover sheet and the information contained herein neither replaces nor supplements the filings and service of pleading or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. Consequently a civil cover sheet is submitted to the Clerk of Court for each civil complaint filed. The attorney filing a case should complete the form as follows:

**I. (a) Plaintiffs - Defendants.** Enter names (last, first, middle initial) of plaintiff and defendant. If the plaintiff or defendant is a government agency, use only the full name or standard abbreviations. If the plaintiff or defendant is an official within government agency, identify first the agency and then the official giving both name and title.

(b) County of Residence. For each civil case filed, except U.S. plaintiff cases, enter the name of the county where the first listed plaintiff resides at the time of filing. In U.S. plaintiff cases, enter the name of the county in which the first listed defendant resides at the time of filing (NOTE: In land condemnation cases the county of residence of the "defendant" is the location of the tract of land involved.)

(c) Attorneys. Enter firm name, address, telephone number, and attorney or record. If there are several attorneys, list them on an attachment, noting in this section "(see attachment)".

**II. Jurisdiction.** The basis of jurisdiction is set forth under Rule 8(a), F.R.C.P., which requires that jurisdictions be shown in pleadings. Place an "X" in one of the boxes. If there is more than one basis of jurisdiction, precedence is given in the order shown below.

United States plaintiff. (1) Jurisdiction is based on 28 U.S.C. 1345 and 1348. Suits by agencies and officers of the United States are included here.

United States defendant. (2) When the plaintiff is suing the United States, its officers or agencies, place an X in this box.

Federal question. (3) This refers to suits under 28 U.S.C. 1331, where jurisdiction arises under the Constitution of the United States, an amendment to the Constitution, an act of Congress or a treaty of the United States. In cases where the U.S. is a party, the U.S. plaintiff or defendant code takes precedence, and box 1 or 2 should be marked.

Diversity of citizenship. (4) This refers to suits under 28 U.S.C. 1332, where parties are citizens of different states. When Box 4 is checked, the citizenship of the different parties must be checked. (See Section III below; federal question actions take precedence over diversity cases.)

**III. Residence (citizenship) of Principal Parties.** This section of the JS-44 is to be completed if diversity of citizenship was indicated above. Mark this section for each principal party.

**IV. Cause of Action.** Report the civil statute directly related to the cause of action and give a brief description of the cause.

**V. Nature of Suit.** Place an "X" in the appropriate box. If the nature of suit cannot be determined, be sure the cause of action, in Section IV more than one nature of suit, select the most definitive.

**VI. Origin.** Place an "X" in one of the seven boxes.

Original Proceedings. (1) Cases which originate in the United States district courts.

Removed from State Court. (2) Proceedings initiated in state courts may be removed to the district courts under Title 28 U.S.C., Section 1441. When the petition for removal is granted, check this box.

Remanded from Appellate Court. (3) Check this box for cases remanded to the district court for further action. Use the date of remand as the filing date.

Reinstated or Reopened. (4) Check this box for cases reinstated or reopened in the district court. Use the reopening date as the filing date.

Transferred from Another District. (5) For cases transferred under Title 28 U.S.C. Section 1404(a). Do not use this for within district transfers or multidistrict litigation transfers.

Multidistrict Litigation. (6) Check this box when a multidistrict case is transferred into the district under authority of Title 28 U.S.C. Section 1407. When this box is checked, do not check (5) above.

Appeal to District Judge from Magistrate Judgment. (7) Check this box for an appeal from a magistrate's decision.

**VII. Requested in Complaint. Class Action.** Place an "X" in this box if you are filing a class action under Rule 23, F.R.Cv.P.

Demand. In this space enter the dollar amount (in thousands of dollars) being demanded or indicate other demand such as a preliminary injunction.

Jury Demand. Check the appropriate box to indicate whether or not a jury is being demanded.

**VIII. Related Cases.** This section of the JS-44 is used to reference relating pending cases if any. If there are related pending cases, insert the docket numbers and the corresponding judge names for such cases.

Date and Attorney Signature. Date and sign the civil cover sheet.





UNITED STATES DISTRICT COURT  
DISTRICT OF NEW JERSEY

L'OREAL S.A. and  
L'OREAL USA, INC.,

Plaintiffs,

v.

THE ESTÉE LAUDER COMPANIES INC.,  
ESTÉE LAUDER INC., and  
ORIGINS NATURAL RESOURCES INC.,

Defendants.

Civil Action No.: 04-1660 (HAA)

May 27, 2004

**JURY TRIAL DEMANDED**

**DEFENDANTS' ANSWER AND COUNTERCLAIMS**

Defendants, The Estée Lauder Companies Inc., Estee Lauder Inc., and  
Origins Natural Resources Inc. (collectively "Estee Lauder"), file this Answer and  
Counterclaims in response to Plaintiffs L'Oreal S.A. and L'Oreal USA, Inc.'s  
(collectively "L'Oreal") Complaint For Patent Infringement ("the Complaint"):

**ANSWER**

**NATURE OF THE ACTION**

1. Estee Lauder admits only that the Complaint purports to bring a civil  
action for patent infringement. Estee Lauder denies the remaining allegations of  
Paragraph 1 of the Complaint.

**THE PARTIES**

2. Estee Lauder is without knowledge or information sufficient to form a  
belief as to the truth of the allegations of Paragraph 2 of the Complaint and accordingly  
these allegations are denied.

3. Estee Lauder is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 3 of the Complaint and accordingly these allegations are denied.

4. Estee Lauder is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 of the Complaint and accordingly these allegations are denied.

5. Estee Lauder admits that The Estée Lauder Companies Inc. is a corporation organized and existing under the laws of the state of Delaware, having its principal executive offices at 767 Fifth Avenue, New York, New York 10153. Estee Lauder denies the remaining allegations of Paragraph 5 of the Complaint.

6. Estee Lauder admits that Estee Lauder Inc. is a corporation organized and existing under the laws of the state of Delaware, having its principal executive offices at 767 Fifth Avenue, New York, New York 10153, and that Estee Lauder Inc. is a subsidiary of The Estée Lauder Companies Inc. Estee Lauder denies the remaining allegations of Paragraph 6 of the Complaint.

7. Estee Lauder admits that Origins Natural Resources Inc. is a corporation organized and existing under the laws of the state of Delaware, having its principal executive offices at 767 Fifth Avenue, New York, New York 10153 and that Origins Natural Resources Inc. is a subsidiary of Estee Lauder Inc. Estee Lauder denies the remaining allegations of Paragraph 7 of the Complaint.

8. Estee Lauder admits that Estee Lauder Inc. and Origins Natural Resources Inc. are engaged in the business of selling cosmetic products and have sold such products

in New Jersey and elsewhere in the United States. Estee Lauder denies the remaining allegations of Paragraph 8 of the Complaint.

### **JURISDICTION AND VENUE**

9. Estee Lauder admits only that the Complaint purports to bring an action for patent infringement arising under the Patent Laws of the United States. Estee Lauder denies the remaining allegations of Paragraph 9 of the Complaint.

10. Estee Lauder admits only that L'Oreal purports to invoke the jurisdiction of this Court pursuant to 28 U.S.C. §§ 1331 and 1338(a). Estee Lauder denies the remaining allegations of Paragraph 10 of the Complaint.

11. Estee Lauder admits only that Estee Lauder Inc. and Origins Natural Resources Inc. have sold cosmetic products in this judicial district. Estee Lauder denies the remaining allegations of Paragraph 11 of the Complaint.

12. For purposes of this action only, Estee Lauder does not contest that this Court has personal jurisdiction over Estee Lauder. Estee Lauder denies the remaining allegations of Paragraph 12 of the Complaint.

13. For purposes of this action only, Estee Lauder does not contest that venue is proper in this judicial district. Estee Lauder denies the remaining allegations of Paragraph 13 of the Complaint.

### **FIRST COUNT FOR PATENT INFRINGEMENT**

14. Estee Lauder admits that United States Patent No. 6,716,420 B2 (the "420 patent") was issued on April 6, 2004, is entitled "Methods of Use and of Making a Mascara Comprising at Least One Coloring Agent and at Least One Heteropolymer," and

that a copy of the '420 patent is attached to the Complaint as "Exhibit A." Estee Lauder denies the remaining allegations of Paragraph 14 of the Complaint, and in particular that the '420 patent was duly and legally issued.

15. Estee Lauder is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 15 of the Complaint and accordingly these allegations are denied.

16. Estee Lauder is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 16 of the Complaint and accordingly these allegations are denied.

17. Estee Lauder denies the allegations of Paragraph 17 of the Complaint.

18. Estee Lauder admits that subsequent to April 6, 2004, the issue date of the '420 patent, one or more of Estee Lauder Inc's subsidiaries, divisions or affiliates has made, offered to sell, sold and/or imported in the United States mascaras marketed under the trademark "Pure Drama MagnaScopic Maximum Volume Mascara," and the trademark "Full Story<sup>TM</sup> Lush-lash Mascara." Estee Lauder denies the remaining allegations of Paragraph 18 of the Complaint.

19. Estee Lauder admits that copies of ingredient labeling from samples of mascaras marketed under the trademarks "Pure Drama MagnaScopic Maximum Volume Mascara" and "Full Story<sup>TM</sup> Lush-lash Mascara" are attached to the Complaint as "Exhibits B and C." Estee Lauder denies the remaining allegations of Paragraph 19 of the Complaint.

20. Estee Lauder denies the allegations of Paragraph 20 of the Complaint.

**SECOND COUNT FOR PATENT INFRINGEMENT**

21. Estee Lauder incorporates by reference Paragraphs 1-20 of this Answer as if fully set forth herein, in response to Paragraph 21 of the Complaint.

22. Estee Lauder denies the allegations of Paragraph 22 of the Complaint.

23. Estee Lauder denies the allegations of Paragraph 23 of the Complaint.

24. Estee Lauder denies the allegations of Paragraph 24 of the Complaint.

**DAMAGES AND OTHER HARM  
ALLEGED TO HAVE BEEN SUFFERED BY PLAINTIFFS**

25. Estee Lauder denies the allegations of Paragraph 25 of the Complaint.

26. Estee Lauder denies the allegations of Paragraph 26 of the Complaint.

**PLAINTIFFS' PRAYER FOR RELIEF**

Estee Lauder denies that L'Oreal is entitled to the relief requested in Paragraphs 1-7 of L'Oreal's Prayer for Relief or to any other relief.

**FIRST AFFIRMATIVE DEFENSE – FAILURE TO STATE A CLAIM**

L'Oreal has failed to state a claim upon which relief can be granted.

**SECOND AFFIRMATIVE DEFENSE – PATENT INVALIDITY**

Each and every claim of the '420 patent is invalid under at least 35 U.S.C. §§ 101, 102, 103 and/or 112.

### **THIRD AFFIRMATIVE DEFENSE – NONINFRINGEMENT**

Estee Lauder has not infringed, contributorily infringed, or induced the infringement of any valid claim of the '420 patent, either literally or under the doctrine of equivalents.

Estee Lauder has not willfully infringed, contributorily infringed or induced the infringement of any valid claim of the '420 patent, either literally or under the doctrine of equivalents.

### **FOURTH AFFIRMATIVE DEFENSE – PROSECUTION HISTORY ESTOPPEL**

Under the doctrine of prosecution history estoppel, L'Oreal is not entitled to assert a claim scope broad enough to encompass any method or product made, used, offered for sale, sold and/or imported by or on behalf of Estee Lauder due to the limiting nature of representations and amendments and surrender of subject matter made during prosecution of the '420 patent in order to convince the Patent Office to issue that patent.

### **RIGHT TO ASSERT ADDITIONAL DEFENSES**

Estee Lauder's investigations into the allegations set forth in L'Oreal's Complaint are ongoing and discovery has not yet commenced. Estee Lauder expressly reserves the right to assert and pursue additional defenses.

### **ESTEE LAUDER'S COUNTERCLAIMS**

1. Counterclaim plaintiff The Estée Lauder Companies Inc. is a corporation organized and existing under the laws of the state of Delaware, having its principal executive offices at 767 Fifth Avenue, New York, New York 10153.

2. Counterclaim plaintiff Estee Lauder Inc. is a corporation organized and existing under the laws of the state of Delaware, having its principal executive offices at 767 Fifth Avenue, New York, New York 10153.

3. Counterclaim plaintiff Origins Natural Resources Inc. is a corporation organized and existing under the laws of the state of Delaware, having its principal executive offices at 767 Fifth Avenue, New York, New York 10153.

4. The mascara products that are the subject of the Complaint in this action are the result of independent research and development conducted by, or on behalf of, one or more of Estee Lauder Inc.'s subsidiaries, divisions or affiliates. These mascara products are covered by U.S. Patent No. 6,497,861 B1 (the "'861 patent'"), entitled "Stable Cosmetic Emulsion with Polyamide Gelling Agent" and assigned to a subsidiary of Estee Lauder Inc. The '861 patent issued on December 24, 2002 and thus predates L'Oreal's U.S. Patent No. 6,716,420 B2 (the "'420 patent'") by more than a year. In addition, these mascara products are covered by U.S. and foreign patent applications related to the '861 patent and assigned to a subsidiary of Estee Lauder Inc.

5. On information and belief, counterclaim defendant L'Oreal S.A. is a French corporation, having its principal place of business at 14, rue Royale, 75008 Paris, France.

6. On information and belief, counterclaim defendant L'Oreal USA, Inc. is a corporation organized and existing under the laws of the state of Delaware and is a wholly owned subsidiary of L'Oreal S.A., having its corporate offices at 575 Fifth Avenue, New York, New York 10017 and additional offices located in the state of New Jersey.

7. On information and belief, L'Oreal S.A. alleges to be the owner of the '420 patent, and L'Oreal U.S.A., Inc. alleges to be the exclusive licensee under the '420 patent.

8. These counterclaims are for declaratory judgment relief arising under 28 U.S.C. §§ 2201 and 2202, and the patent laws of the United States, 35 U.S.C. § 101 et seq.

9. Subject matter jurisdiction is proper under 28 U.S.C. §§ 1331, 1338(a), and 1367.

10. Venue in this district is proper for Estee Lauder's counterclaims under 28 U.S.C. § 1391(b), (c) and (d).

**COUNT I  
DECLARATORY JUDGMENT OF  
NONINFRINGEMENT OF THE '420 PATENT**

11. Counterclaim plaintiffs The Estée Lauder Companies Inc., Estee Lauder Inc., and Origins Natural Resources Inc. (collectively "Estee Lauder") incorporate by reference the allegations made in their Affirmative Defenses and in Paragraphs 1-10 of their Counterclaims above.

12. Without prior notice, written or otherwise, counterclaim defendants L'Oreal S.A. and L'Oreal U.S.A., Inc. (collectively "L'Oreal") filed a Complaint against Estee Lauder in the United States District Court for the District of New Jersey, alleging that Estee Lauder has infringed, contributed to the infringement of and induced the infringement of the '420 patent. L'Oreal S.A. and L'Oreal U.S.A., Inc. v. Estee Lauder



Companies Inc., Estee Lauder Inc., and Origins Natural Resources Inc., Civil Action

No.: 04-1660 (HAA).

13. An actual controversy exists between Estee Lauder and L'Oreal over the alleged infringement of the '420 patent.

14. Estee Lauder has not infringed, contributorily infringed, or induced the infringement of any valid claim of the '420 patent, either literally or under the doctrine of equivalents.

15. Estee Lauder has not willfully infringed, contributorily infringed, or induced the infringement of any valid claim of the '420 patent, either literally or under the doctrine of equivalents.

**COUNT II**  
**DECLARATORY JUDGMENT OF**  
**INVALIDITY OF THE '420 PATENT**

16. Estee Lauder incorporates by reference the allegations made in its Affirmative Defenses and in Paragraphs 1-15 of its Counterclaims above.

17. An actual controversy exists between Estee Lauder and L'Oreal over the invalidity of the '420 patent.

18. All claims of the '420 patent are invalid in light of the failure to comply with one or more requirements of at least 35 U.S.C. §§ 101, 102, 103 and/or 112.

### **RIGHT TO ASSERT ADDITIONAL COUNTERCLAIMS**

Estee Lauder's investigations into the allegations set forth in L'Oreal's Complaint are ongoing and discovery has not yet commenced. Estee Lauder expressly reserves the right to assert and pursue additional counterclaims.

### **PRAYER FOR RELIEF**

For the reasons set forth above, Estee Lauder prays for the Court's judgment that:

- a) the '420 patent is invalid and each claim of the '420 patent is invalid;
- b) Estee Lauder has not infringed, contributorily infringed, or induced the infringement of any claim of the '420 patent;
- c) L'Oreal's Complaint be dismissed with prejudice;
- d) L'Oreal takes nothing by reason of its claims against Estee Lauder;
- e) this case is exceptional and entitles Estee Lauder to an award of its costs, expenses and attorneys' fees under 35 U.S.C. § 285; and
- f) Estee Lauder be granted such other and further relief at law or equity as the Court may deem just and proper.



**DEMAND FOR JURY TRIAL**

Estee Lauder demands trial by jury on all counterclaims and issues triable by jury.

Respectfully submitted,

By: s/David L. Harris

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May 27, 2004